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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,799	03/12/2004	Robert P. Cassoni	527.1003DIV	8292
23280	7590	12/13/2006	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			YEAGLEY, DANIEL S	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,799

Applicant(s)

CASSONI, ROBERT P.

Examiner

Daniel Yeagley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/21/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14 – 33 are rejected under 35 U.S.C. 102(a) as being anticipated by St. Clair '257.

St. Clair shows a mountable device *for* a golf car (figure 1 and 2) comprising a frame *for* placement in a bag bay 11 or 12 of a golf car, a frame section 17 or 21 that contacts a bottom of a bag bay and an attachment device 29 (figure 3) which contacts a bag holder frame 11 of the bag bay, and a first and second hitch (left side 41, 44a, 47a, and right side 42, 44a, 47a) which are connected to the frame (figure 2), such that hitch elements 41 and 42 at least partially extend downward from the frame section so as to at have a height similar to a bumper which at least partially extend downward over the bumper of the golf car and located side-by-side at the rear of the golf car (figure 2) and wherein the first hitch includes one of a mount tube and a mount bracket which includes a claw (lower portion of 18, (figure 4) which holds the golf bag and carrier) and includes a first and second actuator (manually driven left and right actuators 22) that move the hitches, wherein a first and second detachable golf club carrier 14 have at least one wheel *for* contacting ground and a golf bag held by a holding device (figure 2, column 3, line 42-43), wherein the carriers are attachable to either one of the first and second hitches and support the entire weight of the carriers when the wheels are off the ground; when the hitches are moved with respect to a portion of the frame 24 as broadly claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hokaku et al '954 in view of Casady '746.

Hokaku discloses a mountable device having a frame comprising a frame section contacting a bottom of a bag bay and an attachment device that contacts a bag holder frame (figure 1-11), and includes a hitching device at the rear of the golf car that at least partially extend downward from the frame section over a bumper of the golf car, so as to at have a height similar to a bumper and is movable with respect to the frame by a driven actuator (figure 2 - 11), wherein the first hitching device includes one of a mount bracket having a claw 7 and a mount tube attachable to a detachable device (detachable golf club carrier 2) comprising a golf bag held by a holding device, wherein the detachable golf club carrier has at least one wheel and is supported by the hitch device when the wheel is off the ground, such that the golf club carrier is rotatable with respect to the frame to lift the wheel (figure 2-4) and the entire weight of the detachable device is supported by the hitch device as claimed and further discloses lifting a plurality of golf bags by the hitch device, but failed to show a second hitch device and detachable device.

Casady discloses the art of incorporating a plurality of hitching devices located side-by-side at the rear of the golf car (figure 1) to lift individual detachable devices.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mountable device of Hokaku and added additional hitching devices to the golf car of Hokaku in order to hitch additional golf club carriers to a single car in order to reduce the cost of renting a second golf car when more than two people are playing; as clearly taught by Casady, which would additionally support individual detachable devices, as further suggested by the individually lifted golf club carriers of Casady, simple as an alternative means for hitching individual detachable device one at a time; rather than a plurality of device all at once, in order to obtain access to only one detachable device at a time; if desired, as suggested by Casady and which would further reduce the cost, weight, stress and possible fatigue and failure to a single hitch device lifting all the detachable devices at once.

5. Claims 27 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casady '746 in view of Tang '031.

Casady shows a mountable device for a golf car comprising first and second hitching devices 29, 30 connected to and movable with respect to a frame 11, the frame being connected to the golf car by at least one attachment device 14, the hitching device having one of a mount tube and bracket which includes a claw 29a and includes a first and second detachable devices being a golf bag carrier that includes a golf bag attached by holding means (top and bottom rings of carrier bag carrier), but failed to show the detachable carriers having at least one wheel for contacting the ground.

Tang shows a golf bag carrier (detachable device) having a golf bag 10 attached by holding means S that includes the feature of at least one wheel for contacting the ground.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified or replaced the golf bag carrier with a golf bag carrier having at least one wheel for contacting the ground as suggested by Tang as it is well known and clearly obvious to one of ordinary skill in the art to utilize wheels on a golf bag carrier in order to wheel the bag around instead of carrying the bag for less fatigue, safety and simply more convenient.

Response to Arguments

6. Applicant's arguments filed 9/21/06 have been fully considered but they are not persuasive. In response to applicant's argument that St. Clair is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the vehicular car of St. Clair intended use is for mounting a golf club carrier to carry its passengers and their golf carriers to various locations which is equivalent to the function of a typical golf cart or golf car; and is clearly analogous. Wherein a frame section of the mountable device frame of St. Clair clearly contacts a bottom portion of a bag bay; (the bag bay being the area of the rear portion of the car which supports the wheeled golf bag carriers and the mountable device). Such that the hitches of the mountable device (left and right sides of the lower portion of 18 that supports the two bag carriers is connected to the frame; upper portion of 18, and extends at least partially downward from a frame section of the frame and extends over the bumper as shown in figure 2 as broadly

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claimed. Wherein the hitches include mount tubes and mount brackets that include a *claw*; (“any of a various sharp curved processes esp. at the end of a limb”; Merriam Webster’s Collegiate Dictionary, tenth edition). The mountable device of St Clair further includes driven actuators (the manually actuated brackets 22 which clearly actuate the mounting device to a pivoted position and further shows an attachment device 29 that contacts a bag holder frame (figure 3). Regarding applicants’ argument that the first hitching device supports an entire weight of the first detachable device when the first wheel is off the ground is not persuasive because Casady individual hitching devices would also support the entire weight of the detachable device when the wheel leaves the ground until it is positioned over the bag bay and therefore is readable as broadly claimed. In response to applicant's argument that there is no motivation to use the teaching of Casady as Hokaku already provides for multiple golf bags in a single carrier, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Casady clearly teaches the use of utilizing additional hitches on a single car in order to provide additional hitches for additional players, in order to gain the advantage of renting only one vehicle instead of two when there are additional players (column 1).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Yeagley whose telephone number is (571)-272-6655. The examiner can normally be reached on Mon. - Fri; first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on (571) - 272 - 6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D.Y.


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